REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-35 and 37-41 are cancelled and replaced by claims 60-98. Claim 36 is cancelled because of the rejection under 35 U.S.C. §101 and the coverage provided by claims 42–59, which are amended to preclude interpretation in accordance with 35 U.S.C. §112, sixth paragraph. The new claims do not include the language objected to in the Office Action. All claims now indicate the digital store stores game objects.

Added claims 60-98 define the functions of claims 1-35 and 37-41 but indicate the functions are performed under the control of steps by a computer program. The computer program responds to user inputs supplied to a control to cause a transceiver, processor, output device, and digital object store to perform certain operations so the user of the entertainment machine can, by using the control, exercise at least some control over swapping of digital game objects between the digital object stores of the machine and the another machine. The latter feature is not disclosed by the applied references. Since independent claim 60 includes limitations not found in the art of record, claims 61-98, which depend on claim 60, are also allowable.

Applicants traverse the rejection of claim 42 as being anticipated by Hawkins et al. (U.S. 6,516,202). The Office Action alleges Hawkins includes a:

> computer program product comprising code that when loaded into the portable entertainment machine causes the portable entertainment machine to be capable of swapping, by way of the transceiver device, (signals that are representative of digital objects for swapping digital objects between digital object stores of two or more such entertainment machines (sic).

Applicants cannot find any such code in Hawkins and notes the Office Action makes no mention of a specific place where such code can be found in the reference.

Applicants note the statement in the paragraph bridging pages 14 and 15 of the Office Action discussing claims 14 and 18:

> If a message indicator is present, the user is able to make a decision on whether to download the voicemail, text or e-mail message. If the user decides to download the message, the mobile computer system must send information from the transmitter to the similar machine to retrieve the message.

The Examiner apparently takes the position that the swapping referred to in the Office Action is inherent in Hawkins. However, the Examiner has not met the burden of proving an inherent operation. The fact that a certain result or characteristic ***may*** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is ***necessarily*** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

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Since the Examiner has not provided a rationale or evidence to show that Hawkins inherently provides swapping, the rejection based on Hawkins is incorrect and must be withdrawn.

If the rejection is maintained, the Examiner is requested to indicate where and/or how Hawkins discloses the foregoing feature. The secondary references do not cure this defect in Hawkins.

In rejecting claim 45, the Office Action relies on Hawkins and Langseth (U.S. 6,741.980), contending:

> When a subscriber signs up to receive a service, that action can be considered a continuous request for information and data, or a standing instruction to swap data objects if requested data objects become available. A channel can be information and transactional data about a particular field of interest, such as business, weather, sports, news, investments, traffic and others. For example, a weather channel could deliver information and data about weather conditions when a special weather alert is present (Column 9, lines 39-54).

However, this action is not a swap because it involves only one-way transmission.

Since claim 42 is not anticipated by Hawkins and the secondary references do not cure the above-noted defect in the rejection of claim 42 based on Hawkins, claims 43-59, which depend on claim 42, are allowable.

Method claim 99 is added to provide Applicants with the protection to which they are believed entitled. Claim 99 is similar to claim 60 and is allowable for at least reasons similar to those discussed above.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are deemed in order and are respectfully requested.

Pursuant to 37 C.F.R. §1.136(a), Applicants hereby request a one-month extension of time in which to respond to the Office Action of August 30, 2004. Authorization for payment of the $110 extension fee is attached. If in error, Applicants hereby authorize the Commissioner to charge any required fees not otherwise provided for, including application processing, extension of time, and extra claims fees, to Deposit Account No. 08-2025.

Respectfully submitted,
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